code to transmit each selected viewer a prize.

REMARKS

Applicants respectfully request reconsideration of the application in view of the above amendments and following remarks. Claims 78-82 have been added to incorporate claims originally filed in the parent application 09/568,292. No new matter has been added. Support for these amendments can be found throughout the specification.

1. The Examiner indicates that the drawings are informal but acceptable for examination purposes. Accordingly, Applicants will provide formal drawings upon indication of allowability.

I. EXAMINER'S RESPONSE TO APPLICANTS' ARGUMENTS

2. In the Examiner's Response at pages 22-23, the Examiner states that "Applicant failed to seasonably challenge the Official Notice evidence of the prior Office Action" and further that "said Official Notice evidence is deemed admitted, and no further references are required in support of the Official Notice evidence." Applicants' respectfully disagree and direct the Examiner's attention to paragraph 4 of Applicants' January 9, 2003 Response explicitly traversing the Examiners' Official Notice, reciting, *inter alia*:

> As to Claims 4-21, 24-40, 42-59, 62-72, and 75-77 the Examiner further states "official notice is taken that both the concepts and the advantages of the elements and limitations of the claims were well known and expected in the art at the time of the invention."
>
> Applicants respectfully traverse the rejection and submit that a prima facie case of obviousness has not been made and that Claims 1-77 would not have been obvious over Small because Small does not teach or suggest the following limitations, nor were they well known and expected in the art at the time of the invention:...

Accordingly, Applicants respectfully contend that they timely traversed the Official Notice evidence and the evidence is not deemed admitted.

3. At page 5 of the Office Action, it appears that the Examiner has withdrawn the prior obviousness rejection of claims 1-77 based solely on Small, in lieu of the combination of Small and De Rafael. However, in the Examiner's Response at pages 2, and 24-25 of the Office Action, it is unclear as to whether the Examiner is maintaining the prior obviousness rejection solely in view of Small.

At page 24 of the Office Action, in response to Applicants' arguments that Small does not teach or suggest the invention, the Examiner states that "this is not the case". At page 25, the Examiner further states that "the prior Office Action ... has detailed with particularity in the independent claims where the features of claims are suggested in the prior art references and where there are teachings in the references to modify and/or combine the references to derive the present invention."

In view of the Applicants prior arguments in response to the first Office Action and the new rejection in this action based on the combination of Small and De Rafael, Applicants believe the Examiner has withdrawn the rejection. Nonetheless, to the extent the Examiner maintains the prior rejection solely in view of Small, Applicants respectfully traverse the rejection. None of the Examiner's citations to Small teach or suggest at least the linking of the viewing an advertisements with the opportunity to win a prize. Specifically, Small does not teach or suggest providing an opportunity to win a prize only after the viewer has watched the advertisement for some minimum period of time. Additionally, Small does not teach or suggest

Applicants' invention for all of the additional reasons discussed below regarding the nonobviousness of Applicants' invention in view of the combination of Small and De Rafael.

II. THE EXAMINER'S NEW REJECTIONS

4. Claim 1 has been rejected under 35 U.S.C. §101 for same invention type double patenting for claiming the same invention as parent application 09/568,292. Applicants note that in an April 24, 2003 telephone interview the Examiner clarified the rejection as a provisional rejection since it is based on a pending application. Accordingly, Applicants will amend or cancel claims of the 09/568,292 application as necessary to overcome this rejection upon indication by the Examiner that the claims of the present application are otherwise allowable.

5. Claims 1-77 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,791,991 to Small ("Small") in view of U.S. Patent No. 6,529,878 to De Rafael ("De Rafael") because "it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of DeRafael with the teachings of Small'. As to Claims 4-21, 24-40, 42-59, 62-72, and 75-77 the Examiner further states Official Notice is taken that both the concepts and advantages of the elements and limitations of the claims were well known and expected in the art at the time of the invention. Applicants traverse these rejections and submit that a prima facie case of obvious has not been made.

Claims 1-77 would not have been obvious over Small in view of De Rafael because neither Small nor De Rafael teach or suggest at least the following limitations, nor were they well known and expected in the art at the time of the invention:

- a minimum initial advertisement viewing period before being able to submit an entry to win a prize as claimed in Claims 1-77;

- a limitation on the period of time during which the viewer may submit an entry to win a prize as claimed in Claims 3, 23, and 41 and the claims that depend therefrom; and
- displaying individual advertisements to a viewer in series as claimed in Claims 23, 62 and 75 and the claims that depend therefrom.

6. Applicants respectfully submit that Claims 1-77 are not obvious over Small in view of De Rafael because neither Small nor De Rafael teach or suggest the use or benefits of controlling the timing of an offering to the viewer of an opportunity to submit an entry to win a prize.

Small discloses the use of games of chance, such as keno or bingo, as a means for distributing cash rewards, coupons or rebates. Small modifies the traditional bingo or keno by hiding the product categories assigned to each square of the board and allowing the player to select product categories from a list. The selected product categories are then matched to the hidden product categories on the board. The product categories in the game board squares may be hidden by ads or logos. Depending on the pattern formed by the matches on the board the player may win cash, coupons or rebates.

De Rafael discloses a system for rewarding viewers of commercial advertisements wherein the viewer is rewarded if he answers questions associated with the advertisement.

Unlike Small and DeRafael, Applicants claim a system and method for advertising by rewarding viewers of advertisements wherein the viewer's attention is maintained by offering the opportunity to earn a reward only after the advertisement has been displayed for some period of time. In the Applicants' invention the controlled time delay, before offering the opportunity to obtain a reward, forces the viewer to be alert to the advertisement while waiting

for the opportunity to appear. A distinct advantage of the Applicants' invention is that, unlike the cited art, the viewer cannot simply "click through" an advertisement and receive the reward without having actually viewed the advertisement. This aspect of Applicants' invention is critical to the effectiveness of the advertisement on the viewer. Small and De Rafael are silent as to the use and benefits of the limitations on timing of the display of the opportunity to the viewer; nothing in Small or De Rafael forces the viewer to actually pay attention to the advertisement. Although De Rafael discloses that each ad presents a question to the user to actively involve the user (col 3, ln 4-9; col 6, ln 28-32), the questions do not test the user on the content of the advertisement. Rather the questions are merely survey type questions that the user can answer indiscriminately at any time without paying attention to the ad and still receive the reward. (col 6, ln 64 - col 7, ln 8).

The Examiner states that Small lacks an explicit recitation of "the advertisement has been displayed to the viewer for a period of time...", but suggests the same. Applicants first traverse the Examiner's statement because it misconstrues what Applicants' claim and the scope of what Small lacks. Claims 1-77 do not only require displaying an ad to the viewer for a period of time as stated by the Examiner, but also require displaying an offer of an "opportunity" to win a prize to a period of time the advertisement has been displayed. When the claims are properly read, none of the Examiner's cited references to Small nor any other disclosure in Small teaches or suggests at least this limitation of claims 1-77.

The Examiner next states that De Rafael "proposes advertisement viewing time modifications that would have applied to the teachings of Small." The Examiner relies on De Rafael (col. 7, 11. 47-62) "users...who viewed a certain advertisement...within a certain time..."

to support this proposition. Applicants respectfully traverse this reading of De Rafael. This citation when read in full is wholly unrelated to the claimed invention and does not teach or suggest the timing limitation. The referenced sentence read in full recites " [t]his information can be as straightforward as the average (mean) number of users 12 who viewed a certain advertisement 24 within a certain period or can be more complex." This disclosure relates to the compilation of statistical data regarding the number of users who viewed an advertisement over a period of time. It does not teach or suggest the timing of the display of an offer to the viewer as claimed in Claims 1-77.

The cited references Small and De Rafael not only lack all of the elements of the claimed invention, but they also lack any motivation to combine elements. It is well settled that a rejection under §103(a) cannot be sustained unless the particular modification is suggested by the prior art itself. An Examiner cannot merely point to the disclosure of certain individual claim elements in each reference and then, without more, conclude that it would have been obvious to one of ordinary skill to combine these references. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). There must be something in the prior art as a whole that suggests the desirability, and thus the obviousness of making the modification.

Accordingly, Applicants respectfully submit that the Small patent in combination with the De Rafael patent does not teach or suggest the Applicants' claimed invention. Since the references cited do not teach or suggest what the Applicants claim in Claims 1-77, a prima facie case of obviousness has not been made. Withdrawal of the rejections is respectfully requested.

7. As to Claims 4-21, 24-40, 42-59, 62-72, and 75-77 the Examiner further states Official Notice is taken that both the concepts and the advantages of the elements and limitations

of the claims were well known and expected in the art at the time of the invention because "such concepts and the advantages would have provided means of 'targeting ... advertisements and responding to consumer preferences' and would have provided means for 'an improved consumer product promotion method ... which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhance interest for consumers.'" (citations omitted). Applicants traverse this rejection.

The Official Notice relates solely to dependant claims believed to be allowable because they depend from independent claims believed to be allowable in view of the foregoing remarks. Accordingly, Applicants respectfully submit that the Official Notice is moot. Nonetheless, the cited passages merely present goals or objectives. The expression of an objective in a prior art reference does not render undisclosed systems and methods of achieving that objective as obvious and/or well known. In addition, unlike the cited references, it is not an objective of the present invention to reduce or minimize expense. Rather, the invention is intended to create a premier advertising venue which can command high fees from advertisers. Neither Small nor De Rafael teach or suggest the achievement of the recited objectives in the manner claimed by Applicants' invention. Accordingly, Applicants' traverse these rejections and submit that a prima facie case of obvious has not been made.

8. Applicants respectfully submit that Claims 3, 23 and 41 are further not obvious over Small in view of De Rafael because neither Small nor De Rafael teach or suggest the use or benefits of limiting the period of time during which the viewer may submit an entry to win a prize, so that the opportunity is a fleeting opportunity. Claims 3, 23 and 41 of Applicants'

invention limit the period of time during which a viewer has the opportunity to submit an entry to win a prize. By this means, the viewer must remain especially alert and pay attention to the advertisement so as not to miss the opportunity. The limitation on time is critical to the effectiveness of the advertisement because the viewer must remain focused on the advertisement. If the viewer looks away he may miss the fleeting opportunity to submit an entry for the prize.

As discussed above, Small is silent as to any critical timing aspect on the display of ad squares in its keno, and there are no other functions suggested or disclosed that serve to require the player to pay attention to any ads or logos on the game board. Similarly, as also discussed above, De Rafael is silent as to any time restrictions on the offering of the question which must be answered to receive a reward, no less, disclosing or suggesting a limitation on the duration of time the user would have to recognize the presence of the question and answer it.

Accordingly, Applicants respectfully submit that Small in combination with De Rafael does not teach or suggest this further limitation of Claims 3, 23 and 41. Since the references cited do not teach or suggest this further limitation claimed in Claims 3, 23 and 41, a prima facie case of obviousness has not been made. Withdrawal of the rejections and allowance of Claims 3, 23 and 41 is respectfully requested. Claims 4-21, 24-40, 42-59, and 76-77 depend from and further limit Claims 3, 23 or 41 and are thus also believed to be allowable.

9. Applicants respectfully submit that Claims 23, 62 and 75 are further not obvious over Small in view of De Rafael because neither Small nor De Rafael teach or suggest the serial display of advertisement to a viewer.

Claims 23, 62 and 75 of Applicants' invention claim the display of advertisements to the viewer in series. The serial display of advertisements permits the viewer to watch

advertisements one after another. The serial display makes the viewing process easy for the viewer and is thus likely to keep the viewer interested for longer uninterrupted periods.

Small only discloses the use of ads or logos to block the squares of the game board matrix and is silent as to serial display.

De Rafael discloses the ability of the user to view advertisement one at a time by selecting an advertisement, answering the questions, and then going back to select another advertisement. Accordingly, De Rafael requires extensive involvement on the part of the user to keep the advertising process going.

Unlike De Rafael, the distinct advantage of the present invention is that the serial display of advertisement requires no input or effort from the viewer so that they will continue until the viewer decides to quit. While the advertisements are displayed in series the user can easily watch the advertisements and click on the opportunities to win a prize when they appear.

Accordingly, Applicants respectfully submit that the Small patent in combination with the De Rafael patent does not teach or suggest this further limitation of Claims 23, 62 and 75. Since the references cited do not teach or suggest this further limitation, a prima facie case of obviousness has not been made. Withdrawal of the rejections and allowance of the claims is respectfully requested. Claims 24-40, 76 and 77 depend from and further limit Claims 23, 62 or 75 and are thus also believed to be allowable.

10. Applicants have added new Claims 78-82. These claims originally appeared in the parent application and were rejected under 35 U.S.C. §103(a) as being obvious over Small.

New Claims 78-82 contain the same timing limitation as Claim 1 and are therefore believed to be allowable for the reason set forth above.

11. As discussed above, Applicants contend that because the Small patent in combination with the De Rafael patent does not teach or suggest what the Applicants claim, a prima facie case of obviousness has not been made. Accordingly, reconsideration and withdrawal of the rejections under §103(a) is respectfully requested.

CONCLUSION

Based on the foregoing remarks, it is respectfully submitted that the claims are patentable and in condition for allowance.

If any issues remain, or if the Examiner has any suggestions for expediting allowance of this application, he is respectfully requested to contact the undersigned at the telephone number listed below.

Favorable consideration is respectfully requested.

PATENT
Docket No. 4022-4001US1

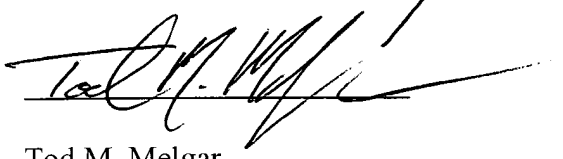
AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for this amendment, or credit any overpayment to Deposit Account No. 13-4500, Order No. 4022-4001US1. **A DUPLICATE OF THIS DOCUMENT IS ATTACHED.**

Respectfully submitted,

MORGAN & FINNEGAN, L.L.P.

Dated: May 8, 2003

By: 

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APPENDIX

78. (New) A computer system configured to:

receive an advertisement;

display the advertisement;

display an opportunity to submit an entry in conjunction with the advertisement wherein the opportunity to submit the entry is only available after the advertisement has been displayed to the viewer for a period of time; and

transmit an entry to win a prize.

79. (New) A computer system configured to:

prepare an advertisement for display to a viewer in exchange for offering the viewer an opportunity to submit an entry to win a prize in conjunction with viewing the advertisement wherein the opportunity to submit the entry is only available after the advertisement has been displayed to the viewer for a period of time;

transmit the ad to an ad server for transmission to viewers;

receive viewer contact information for each viewer selected to win a prize; and

transmit each selected viewer a prize.

80. (New) Computer executable software code stored on a computer readable medium, the code for advertising to a viewer wherein by viewing an advertisement a viewer may qualify to win a prize, comprising:

code to receive a plurality of advertisements;

code to store the advertisements on a server;

code to register a plurality of viewers by obtaining viewer information data for each viewer including at least the viewers' contact information;

code to transmit the plurality of advertisements to each viewer for display on a monitor in series, wherein each advertisement is an interstitial advertisement having an associated prize offering, the advertisement being displayed for a time period having a first portion of time during which the viewer is not offered an opportunity to submit an entry to win the prize followed by a second portion of time during which the viewer is offered the opportunity to submit an entry to win the prize;

code to determine for each advertisement whether each viewer chose to submit an entry for the associated prize;

code to identify the viewers, who chose to submit an entry, as entrants;

code to select an entrant as a winner to receive the prize; and

code to notify the winner that they have won the prize.

81. (New) Computer executable software code stored on a computer readable medium, comprising:

code to receive an advertisement;

code to display the advertisement;

code to display an opportunity to submit an entry in conjunction with the advertisement wherein the opportunity to submit the entry is only available after the advertisement has been displayed to the viewer for a period of time; and

code to transmit an entry to win a prize.

82. (New) Computer executable software code stored on a computer readable medium, comprising:

code to prepare an advertisement for display to a viewer in exchange for offering the viewer an opportunity to submit an entry to win a prize in conjunction with viewing the advertisement wherein the opportunity to submit the entry is only available after the advertisement has been displayed to the viewer for a period of time;

code to transmit the ad to an ad server for transmission to viewers;

code to receive viewer contact information for each viewer selected to win a prize; and

code to transmit each selected viewer a prize.